

REMARKS

The instant Restriction Requirement includes claim 66 in Group IIc. However, claim 66 is directed to antibodies which specifically bind to polypeptides of SEQ ID NO:3 while Group IIc includes claims directed to antibodies which specifically bind to polypeptides of SEQ ID NO:5. Therefore, Applicants submit that claim 66 should properly be included in Group IIb, which is directed to antibodies which specifically bind to polypeptides of SEQ ID NO:3, rather than in Group IIc.

The Restriction Requirement asserts that the claims are directed to patentably distinct products that are "physically and functionally distinct, as illustrated by the distinct and unique SEQ ID NOs of the polypeptides of SEQ ID NOs: 1, 3 & 5 required to generate the distinct antibodies of Groups IIa-c" (Office Action, August 12, 2003; page 4, § 7). In response to this Restriction Requirement, **Applicants hereby elect Group IIb** (including claims 11, 31, 32, 34, 36-43, 62, and 64), comprising antibodies which specifically bind to polypeptides of SEQ ID NO:3, compositions comprising the antibodies, and methods of making the antibodies, with traverse.

The traversal is based in part on the Patent Office guidelines for restriction as set out in the M.P.E.P. at § 803:

There are two criteria for a proper requirement for restriction between patentably distinct inventions:

(A) The inventions must be independent (see MPEP § 802.01, § 806.04, § 808.01) or distinct as claimed (see MPEP § 806.05 - § 806.05(i)); and

(B) There must be a serious burden on the examiner if restriction is required (see MPEP § 803.02, § 806.04(a) - § 806.04(i), § 808.01(a), and § 808.02).

At the very least, the restriction is improper because it does not meet the second of these criteria. For example, there is no serious burden to examine the claims of Group IIa along with the claims of Group IIb because a search and examination of antibodies which specifically bind to polypeptides of SEQ ID NO:1 would significantly overlap with a search and examination of claims directed to antibodies which specifically bind to polypeptides of SEQ ID NO:3.

A sequence alignment between SEQ ID NO:1, SEQ ID NO:3, and other polypeptides is presented in Figures 2A, 2B, 2C, and 2D of the application. This sequence alignment shows that 470 amino acids are identical between SEQ ID NO:1 and SEQ ID NO:3 (SEQ ID NO:1 has a total of 477 amino acid residues; SEQ ID NO:3 has a total of 476 amino acid residues). Therefore, SEQ ID NO:1 is at least 98% identical (470 identical residues divided by 477 total residues) to SEQ ID NO:3. Based on this high degree of similarity between SEQ ID NO:1 and SEQ ID NO:3, there would be very little additional work required to search the claims of Group IIa along with the claims of Group IIb. Thus, the restriction requirement should be withdrawn, at least with respect to Groups IIa and IIb.

In addition, the claims of Group IIb include an isolated antibody which specifically binds to a polypeptide comprising a naturally occurring amino acid sequence at least 90% identical to SEQ ID NO:3, wherein the polypeptide has carboxypeptidase activity (e.g., part (b) of claim 11). Since SEQ ID NO:1 is at least 98% identical to SEQ ID NO:3, a search and examination of the claims of Group IIb would necessarily include antibodies which specifically bind to polypeptides of SEQ ID NO:1. This is further evidence that there would be minimal additional burden on the Patent Office to search and examine the claims of Group IIa along with the claims of Group IIb.

For at least the above reasons, Applicants request withdrawal of the restriction requirement.

With respect to the previous Restriction Requirement (mailed on May 6, 2003; election with traverse made on June 2, 2003), the Office Action states that "because none of the claims in elected Group II are allowable, etc., no rejoining of these groups is required" (Office Action, August 12, 2003; page 2). Nevertheless, upon determining allowability of the product claims, Applicants presume that method claims commensurate in scope with any allowed product claims will be rejoined.

Applicants reserve the right to prosecute non-elected subject matter in subsequent divisional applications.

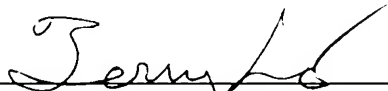
If the Examiner contemplates other action, or if a telephone conference would expedite allowance of the claims, Applicants invite the Examiner to contact the undersigned at (650) 621-8581.

Applicants believe that no fee is due with this communication. However, if the USPTO determines that a fee is due, the Commissioner is hereby authorized to charge Deposit Account No. **09-0108**.

Respectfully submitted,

INCYTE CORPORATION

Date: Sep. 2, 2003



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Limited Recognition (37 C.F.R. § 10.9(b)) attached

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